

REMARKS

Claims 1, 4-14, 16-23, 46, 48-56, 82 and 88-89 are pending. In the Office Action, the Examiner rejected the claims as follows. Claim 88 was rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Claims 1, 4-14, 16-23, 46, 48-56 and 82 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 52-56 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claim 89 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 14 and 16-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2001/0034630 A1 (Mayer) in view of U.S. Patent No. 6,434,580 (Takano). Claims 52-56 were rejected under 35 U.S.C. §103(a) as being unpatentable over www.inventors.net retrieved from the Internet Archive Wayback Machine (InoNet) in view of U.S. Patent Publication No. 2004/0249902 (Tadayon) and further in view of Mayer. Claims 1, 4-6, 8-13, 46 and 48-51 were rejected under 35 U.S.C. §103(a) as being unpatentable over InoNet in view of Mayer. Claim 88 was rejected under 35 U.S.C. §103(a) as being unpatentable over InoNet in view of Mayer and further in view of Tadayon. Claim 82 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mayer in view of InoNet and further in view of Tadayon. Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over InoNet and Mayer and further in view of U.S. Patent Application No. 2001/0047276 A1 (Eisenhart). Claim 89 was rejected under 35 U.S.C. §103(a) as being unpatentable over InoNet in view of Mayer and further in view of U.S. Patent No. 6,301,574 (Thomas).

It is initially submitted that the earliest filing date of Mayer et al. is April 21, 2000. Filed herewith is a Declaration under 37 C.F.R. §1.131 antedating Mayer et al. In support thereof and filed herewith is an invention disclosure establishing reduction to practice of the invention of the pending application in the United States prior to April 21, 2000, which is the earliest filing date of Mayer et al. Based on at least the foregoing, any and all rejections based entirely or in part on

Mayer et al. must be withdrawn. It is respectfully submitted that based on at least the foregoing, all of the rejections of Claims 1, 4-14, 16-23, 46, 48-56, 82 and 88-89 must be withdrawn.

Regarding the Examiner's rejection of Claim 88 under 35 U.S.C. §112, first paragraph, the Examiner states that the recitation of determining by the first computing device a confidentiality level for the proposal for inventions is not described in the specification in such a way as to enable one skilled in the art to which it pertains to make or use the invention without undue experimentation. First, as recited in this specific feature it is the proposal for inventions for which a confidentiality level is determined. It appears that the Examiner is confusing the "confidentiality level for the proposal for inventions" with other confidentiality levels described in the specification and recited in the claims.

The "confidentiality level for the proposal for inventions" is clearly defined at least at page 30, line 11 – page 31, line 21, which reads:

Returning to FIG. 3, after the initial inventor 100 inputs the appropriate information in the Patent Proposal Input Web page, the input information is transferred over the secure network 155 to the Patent Proposal database 112. At this point, the Patent Proposal Database Server 112 creates a Patent Proposal Database Record for this patent proposal. The Patent Proposal Database Server 112 is responsible for understanding the requirements sent by the initial inventor 100 and choosing which users to solicit with the patent idea. The Patent Proposal Database Server 112 uses the co-inventor requirements and patent proposal description to help select a solicitation list of possible co-inventors. The Security System 150 establishes a confidentiality level for each Patent Proposal record in the Patent Proposal Database Server 112, by determining the importance of the idea. The "importance" of an idea may have different meanings, depending on the corporation or entities involved. For instance, it may mean economic gain, level of need for that proposed idea in the corporation, and it may depend on other issues, such as whether or not the corporation is working with other corporations in the same area.

The Security System 150 may have a central processing unit (CPU) which uses a heuristic analysis program to weigh these factors and determine an appropriate confidentiality level. On the other hand, the Security System 150 may

analyze the data and present a report to a patent proposal committee or patent proposal manager, who determines the appropriate level of confidentiality based on their knowledge of the situation and contact with other managers in the corporation. In short, the Security System 150 represents any type of system, computer or human, which designates a confidentiality level for a patent proposal.

One skilled in the art would clearly be capable of making and using the invention without undue experimentation. For at least the above-stated reasons, it is respectfully requested that the rejection of Claim 88 under 35 U.S.C. §112, first paragraph, be withdrawn.

Regarding the Examiner's rejection of Claims 1, 4-14, 16-23, 46, 48-56 and 82 under 35 U.S.C. §112, first paragraph, the Examiner states that there is inadequate support for the recitation of co-inventor qualifications including information related to at least one of a total number of drafting hours, proposals, drafts, and issued patents and further states that this recitation is new matter. The Examiner correctly indicates that there is disclosure for the subscriber/employee entering information relating to a total number of drafting hours, proposals, drafts, and issued patents. Page 19, lines 18-20, of the pending written description states that that an employee indicates their willingness to be a co-inventor. Therefore, any information entered for an employee is the information for a co-inventor, as the employee has now been indicated as a co-inventor.

For at least the above-stated reasons, it is respectfully requested that the rejection of Claims 1, 4-14, 16-23, 46, 48-56 and 82 under 35 U.S.C. §112, first paragraph, be withdrawn.

Regarding the Examiner's rejection of Claims 52-56 under 35 U.S.C. §112, first paragraph, the Examiner states that recitation of subscriber qualifications including information relating to at least one of a total number of drafting hours, proposals, drafts, and issued patents is new matter. The Examiner correctly indicates that there is disclosure for the subscriber/employee entering information relating to a total number of drafting hours, proposals, drafts, and issued patents, therefore the rejection is moot.

In addition, page 19, lines 18-20, states that that an employee subscribes, i.e. is a subscriber. Therefore, any information entered for an employee is the information for a subscriber, as the employee has now subscribed.

For at least the above-stated reasons, it is respectfully requested that the rejection of Claims 52-56 under 35 U.S.C. §112, first paragraph, be withdrawn.

Regarding the Examiner's rejection of Claim 89 under 35 U.S.C. §112, second paragraph, the Examiner states that "collecting bids; and displaying information related to the collected bids using at least one of a pie chart and graph" is indefinite. The bidding process is clearly described in the written description at least on page 38, line 11 – page 41, line 22, as well as being recited in the originally filed claims, for example, Claims 24, 30-34, 41, 42, 61, 84 and 87. Collecting bids and displaying information related to the collected bids using at least one of a pie chart and graph is clear and definite.

Accordingly, it is respectfully requested that the rejection under 35 U.S.C. §112, second paragraph, of Claim 89 be withdrawn.

Independent Claims 1, 14, 46, 52 and 82 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 4-13, 16-23, 48-51 and 53-56, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 4-13, 16-23, 48-51 and 53-56 is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1, 4-14, 16-23, 46, 48-56 and 82, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining

matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Musella", with a stylized flourish at the end.

Michael J. Musella

Reg. No. 39,310

Attorney for Applicant

THE FARRELL LAW FIRM, PC
333 Earle Ovington Blvd., Suite 701
Uniondale, New York 11553
Tel: (516) 228-3565